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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 10/090,311  | 03/04/2002  | Teruo Masaki         | 7217/66562                    | 5487             |
| 530 7590 01/29/2007<br>LERNER, DAVID, LITTENBERG,<br>KRUMHOLZ & MENTLIK<br>600 SOUTH AVENUE WEST<br>WESTFIELD, NJ 07090 |             |                      | EXAMINER<br>SHIFERAW, ELENI A |                  |
|   |             |                      | ART UNIT<br>2136              | PAPER NUMBER     |
| SHORTENED STATUTORY PERIOD OF RESPONSE  |             |                      | MAIL DATE                     | DELIVERY MODE    |
| 3 MONTHS  |             |                      | 01/29/2007                    | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/090,311 | <b>Applicant(s)</b><br>MASAKI ET AL. |  |
|                              | <b>Examiner</b><br>Eleni A. Shiferaw | <b>Art Unit</b><br>2136              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,7-9 and 13-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7-9 and 13-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

DETAILED ACTION

1. Status of claims:

Claims 1, 2, 4, 7-9, and 13-24 are pending.

Claims 3, 5-6, and 10-12 are canceled.

Claims 15-27 are newly added.

*Response to Amendment*

2. Applicant's amendments and arguments for all independent claims 1, 8, 9, 13, and 14, and newly added claims 15-24 filed on 10/31/2006 have been fully considered but they are not persuasive.

Applicant amends the copyright licensing process prompting apparatus being connectable to the communication network at a location which is remote from the first terminal unit and the second terminal unit and argues the detecting means for authenticating content transmission request to another device, is in the requester's device but not remotely done, as recited in claims 1, 8, 9, 13, 14, (remark page 13 par. 1). Argument is not persuasive because the content transmission request to a second device (0240, and 0251-0263) is authenticated based on access mechanism 114 rules of reference Schneck that are stored in the requester's device **by remote distributor 102 or 190** of fig. 1 and fig. 15 (0170). Packaged data 108 comprising **transmission access rules** and content is generated by the **remote distributor 102 or 190** and transmitted to authorized user device (0087). The user access mechanism 114 access the access rules 116 and enables the user to access the data in various controlled ways, depending on the access rules (0088, 0097-0098, 0323, 0157, 0303, 0313). Transmission access permission certificate is provided by **remote distributor 102 or 190** to authorized users and stored in user's device and

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user transmission access is authenticated based on remote distributor's certificate (0286-0288). Content owner/ remote distributor 102 or 190 upgrades content transmission usage rights (0289). Content usage rights are license expiration dates, time of use, number and frequency of uses and permitted users and etc (0303). Moreover, if the access mechanism 114 of the user is the only detector/authenticator as the applicant argues, the other embodiment of Schneck discloses the access mechanism 114 of the user being operating as a co-processor of another processor or computer (see 0136, and 0135). Therefore the access is remotely controlled. And argument is not persuasive.

The examiner would like to provide Kobata et al. reference that shows the argument as well known for applicant's reference. Global rights management 312 and/or server control unit 338 and/or central rights management 340 of a remote server providing rights to remote users and authenticating user's rights remotely (0075-0084, 0087, 0089-0090).

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 4, 7-9, 13-15, 17, 19, 21, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneck et al. (herein after Schneck) US PG PUBS 2001/0021926 A1.

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Regarding claims 1, 8, 9, and 13-14 Schneck discloses a copyright licensing process promoting apparatus/method/program/medium for promoting a copyright licensing process for literary work data desired to be transmitted from a first terminal unit of a first user to a second terminal unit of a second user via a communication network (0042-0070), said apparatus comprising:

detecting means for accessing the first terminal unit of the first user by way of the communication network and for detecting at the first terminal unit a file of the literary work data to be transmitted from the first terminal unit to the communication network, said detecting means being operable to detect the file at the first terminal unit before the file is transmitted to the communication network (0136, 0286, 0295, 0323, 0043, 0134, 0046, 0251-0254, 0161-0168, 0295, and claim 4; *detecting access rights before allowing secondary distribution of data/redistribution*);

content determining means for determining whether a content of the file to be transmitted to the communication network and detected by said detecting means is valid (claims 2, 67, 45-46, and 0178; *determining access right rules .... is data transmission requested valid or not? ...*);

file processing means for performing a predetermined process for the file before the file is transmitted to the communication network when a result of said content determining means is not valid; and

said apparatus being connectable to the communication network at a location which is remote from the first terminal unit and the second terminal unit (fig. 1, fig. 15, 0251-0253, and 0240).

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As per claim 2, Schneck further discloses the copyright licensing process promoting apparatus, further comprising:

searching means for searching for a location on a predetermined list, referenced via the communication network, at which the file of the literary work data is stored (fig. 13),

wherein said detecting means detects the file being transmitted, the file to be stored at the location searched by said searching means (0251-0254, and 0230-0248).

As per claim 4, Schneck further discloses the copyright licensing process promoting apparatus, further comprising:

literary work data determining means for determining whether the content of the file to be transmitted is literary work data (0089, and 0011); and

copyright licensing process, determining means for determining whether a copyright licensing process has been performed for the literary work data (abstract),

wherein said content determining means determines that the content of the file is valid corresponding to a result of said literary work data determining means and result of said copyright licensing process determining means, and said literary work data determining means represents that the content of the file is literary work data and said copyright licensing process determining means represents that the copyright licensing process has not been performed for the file (0097-0099).

As per claim 7, Schneck further teaches the copyright licensing process promoting apparatus, further comprising:

informing means for informing the first user of the terminal unit that the content of the file is not valid when a result of said content determining means represents that the content of the file is not valid (fig. 11 element S1126, and 0169),

wherein said file processing means performs the predetermined process when the first terminal unit tries to transmit the file although said informing means has informed the first user that the content of the file is not valid (fig. 11 element S1126, 0251-0254, and 0169).

Regarding claims 15, 17, 19, 21, and 23, Schneck discloses the copyright licensing process prompting apparatus wherein the predetermined process for the file is a destruction of the file (claims 56, 43, par. 0139, 0184, 0133, 0055; *destroying/deleting data when illegal access and/or illegal transmission of content to second person is detected*).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16, 18, 20, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneck et al. (herein after Schneck) US PG PUBS 2001/0021926 A1 in view of Kobata et al. USPG PUBs 2002/0077985 A1.

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Regarding claims 16, 18, 20, 22, and 24, Schneck discloses the copyright licensing process promoting apparatus further comprising means for transmitting a warning message to the second terminal unit when a result of said content determining means represents that the content of the file is not valid (0253; if transmission request is not valid transmitting and displaying random data/number or encrypted content that is a warning for not allowed content and the user must contact with the distributor for permission rights).

Schneck discloses authenticating transmission access and if not valid denying access to first and second user and transmitting random number/data or encrypted data to the second user (0253). Schneck does not explicitly disclose warning the authorized user. However Kobata et al. discloses remote authenticator authenticating usage access request and if not valid transmitting a denying message to the user (0135). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Kobata et al. within the system of Schneck because they are analogous in digital data access rights authentication. One would have been motivated to incorporate the teachings of warning the users when access is not authorized is because to clearly notify the result of the authenticating to users and users based on the warning message could perform actions like upgrading license, buying new license and etc.

### *Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser R. Moazzarfi can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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January 24, 2007

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1/25/07